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| 08/865,419 | 05/28/1997 | STEPHEN B. AUGER | CLINK0002 | 8405 |

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EXAMINER

EINSMANN, MARGARET V

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 10/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/865,419

Applicant(s)

AUGER, STEPHEN B.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10, 20-23, 25, 26 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) 23, 25, 26 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-10, 20-22, 30-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The finality of the office action of 08/2/00 is withdrawn due to the new grounds of rejection applied below.

Claims 1-10, 20-23, 25,26, 29-36 are pending. Claims 1-10, 20-22, 30-36 are being examined. Claims 23,25,26 and 29 have been withdrawn from consideration.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 20-22, 30-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 09/932,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a method of coloring wood and a kit for use in said method . Said kits are composed of two components, a solution of a metal salt and a solution of an oxidizing agent. The two components of the kit are applied sequentially to a wood substrate and allowed to react to produce a color on said substrate. The first component as claimed in

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the instant claims limits the solvent to an aqueous solvent and the second component in the instant claims limits the solution to peroxide. In the copending application, both components may be aqueous solutions, the oxidizing agent may be a peroxide. Accordingly, the claims of the two applications are overlapping in scope; the kit claimed in first claim of this application is completely included in the kit as claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following rejections from the office action of 8/2/2000, which were appealed by applicant, are addressed next.

The rejection of claims 1 and 31 as being unpatentable under 35 U. S. C. 112, second paragraph as being indefinite is withdrawn. The last five lines of the claim do not render it indefinite. However, those last five lines are a functional limitation which does not further define the two components of the composition. In examining the claims only the components themselves will be considered. See *In re Schoenwald*, 22 USPQ2d, 1671 which states that a new use for an old composition does not make that composition patentable.

The rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by Matsushita, JP 60-250906. This rejection is maintained for the reasons of record.

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Applicant argues that the method of using the kit is different. However, claim 1 is a composition claim. All that is necessary to reject claim 1 is a two part composition containing an aqueous mineral salt solution and an aqueous peroxide solution.

Matsushita discloses such a composition. See *In re Schoenwald*, 22 USPQ2d, 1671 which states that a new use for an old composition does not make that composition patentable.

The rejection of claims 3-7, 9-10 and 30-36 under 35 U.S.C. 102(b) as being anticipated by Brown, US 5,173,085. is maintained for the reasons of record. Applicant argues that the examiner does not point to all of the components of the composition which is necessary for anticipation. Regarding claims 3-7, 30, 31,32 ,34 example 1 col 8 lines 12 et seq. disclose a 1% aqueous solution of copper sulfate, reading on the second component of applicant's kit as claimed in claims 30, Said composition in example 1 was used with a 6% aqueous hydrogen peroxide solution in example 2 (col 8 lines 37-47). The aqueous peroxide solution is the second component, reading on the limits applicant claims in claims 9 ,10, 33, 35 and 36. Applicant argues that Brown does not color wood. See *In re Schoenwald*, 22 USPQ2d, 1671 which states that a new use for an old composition does not make that composition patentable.

The rejection of claims 3-10 and 30-36 under 35 U.S.C. 102(b) as being anticipated by Tennegkeit, US 4,992,077 is maintained for the reasons of record. Applicant argues that patentee is dyeing hair not wood. All that is needed to anticipate

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the claims is the components as claimed. Patentee discloses a 3 part composition comprising aqueous solutions several metal salts as claimed which is used with aqueous solutions of hydrogen peroxide. See col 3 lines 66-68, example 3a, col 5 lines 21-27 for all of the limitations of the pending claimed compositions. See In re Schoenwald, 22 USPQ2d, 1671 which states that a new use for an old composition does not make that composition patentable.

The rejection of claims 1, 3-6, 9-10 and 32-36 under 35 U.S.C. 102(b) as being anticipated by Light, SU 499,297 is maintained for the reasons of record.

Applicant argues that the claim limitations were not pointed out by the examiner. They are all in the abstract, lines 3-5. Applicant further argues that Light does not treat wood. See above case law.

The rejection of claims 3-7, 30,31 and 36 under 35 U.S.C. 102(b) as being anticipated by Yantai is withdrawn. Yantai does not disclose peroxide.

The rejection of claims 2-8, 9-10, 20-22, 30-34 and 36 under 35 U.S.C. 102(b) as being anticipated by Dombay is maintained for the reasons of record.

Applicant argues that the claim limitations were not pointed out by the examiner. Example 4 discloses a process for treating teak with a kit as claimed in order to obtain a color on the wood. The kit comprises a solution A which contains the metal salt cupric sulfate as well as hydrochloric acid as claimed. The composition is diluted with water

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and applied to the wood. Thereafter the wood is dried. The wood is then treated with a second aqueous solution which contains hydrogen peroxide. See col 3 lines 19-25.

The wood is then treated with a nitrocellulose lacquer (sealant) as claimed. This method takes place at room temperature. Example 5 discloses treating wood with a first composition containing potassium permanganate, wherein the composition is diluted with water. After drying the wood, the wood is treated with a hypochlorite composition and then with a solution of hydrogen peroxide. Therefore, the process as claimed is anticipated.

The rejection of claims 2-8, 9-10, 20-22, 30-34 and 36 under 35 U.S.C. 102(b) as being anticipated by Bures is maintained for the reasons of record. Applicant argues that the examiner has not pointed out the claim limitations and accordingly the claims cannot be anticipated. The examiner now points to the limitations.

A process of staining any kind of wood is taught (p 7 last paragraph) whereby three solutions are applied sequentially to wood. Both the first and last solutions contain metal salts and/or bleaching agents. Page three states that the first step is to treat the wood with at least one salt or at least one peroxide oxidizing agent, and the third step treats with at least one complex of copper, silver, nickel or permanganate. Permanganate is a bleaching agent. Page 5 first paragraph states that the solution of the first step uses a mixture of salts, including alkaline metals and peroxides, hyperoxides, or peracids. The latter three are all oxidizing agents. The wood may be dried between applications (p 7 second paragraph). Example 1 on page 8 discloses

treating dried birch with an aqueous solution comprising hydrogen peroxide and then with an aqueous solution of silver nitrate. In example 2 on page 9, both the first and third solutions contain both bleach and a metal salt; the first solution contains the bleach ammonium persulfate and the metal salt, copper sulfate in an aqueous alcohol solution; the second solution contains potassium permanganate, which is both a bleach and an oxidizing agent, and two other metal salts, zinc sulfate and sodium aluminate. See also claim 1 on page 11 which claims treating wood with a peroxide or peracid in a mixed solvent in a first step, and treating with a compound of silver, copper, nickel or permanganate (bleaching agent) in the last step. Accordingly all of the material limitations of the instant claims are taught.

The rejection of claims 2-8, 9-10, 20-22 and 30-36 under 35 U.S.C. 103(a) as being unpatentable over Dombay is maintained. Applicant argues that the examiner has not pointed to the claim limitations. See above anticipation rejection over Dombay for specific claim limitations.

Applicant argues that Dombay merely coats wood with an oxidizing agent to lighten the wood and uses cupric sulfate as an accelerator. Applicant states that the composition in example 4, pointed to by the examiner is non-aqueous. This is not correct. See col 6 line 50 wherein water is part of the solution. Applicant further argues that Dombay either lightens or darkens wood. Lightening and darkening are both methods of coloring. Applicant states that Dombay does not show a two part kit. A two part kit reading on applicant's claims is disclosed in example 4.

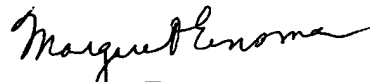
The rejection of claims 2-10, 20-22 and 30-36 under 35 U.S.C. 103(a) as being unpatentable over Bures is maintained. Applicant argues that the examiner has not pointed to the claim limitations. See above anticipation rejection over Bures for specific claim limitations. Applicant argues that Bures does not have a two part process but applies several coats, and uses organic solvents which applicant does not use. Applicant's method claims state that the process "comprises" the indicated steps. Accordingly the process is open to additional process steps. Regarding the statement that nothing in the reference teaches or suggests the kit containing an aqueous solution of mineral salt and an aqueous solution of a peroxide, applicant is directed to example 1 and the above recited anticipation rejection over Bures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret Einsmann
Primary Examiner
Art Unit 1751

October 18, 2002